



AF/3622

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

Eric C. Hannah et al.

Serial No.: 09/690,512

Filed: October 17, 2000

For: Ensuring that Advertisements
are Played

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Art Unit: 3622

Examiner: Stephen M. Gravini

Atty Docket: ITL.0482US
P10030

Dacia Lewis
#13/Reply
Brief
2/13/04

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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REPLY BRIEF

Sir:

This replies to the new points raised by the Examiner's Answer.

**I. The Invention Set Forth In The Application Complies With
Section 101 Pursuant To The Guidelines Set Forth In The
M.P.E.P. And A Reasonable Interpretation Of The Word Watermark**

To make a Section 101 rejection, the Examiner should read the claims and the supporting description, determine what has been claimed, then ensure that the claims define statutory subject matter. See M.P.E.P. § 2107. The Examiner, according to M.P.E.P. Section 2107(II)(B), is to review the claims and the supporting written description to determine if the Applicant has asserted for the claimed invention any specific and substantial utility that is credible. If the Applicant has asserted that the claimed invention is useful for any particular practical purpose

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Cynthia L. Hayden
Cynthia L. Hayden

and the assertion would be considered credible by a person of ordinary skill in the art, the Examiner is not to impose a rejection based on lack of utility.

Where the asserted utility is not specific or substantial, the Examiner must make a *prima facie* showing that it is more likely than not that a person of ordinary skill in the art would not consider that any utility asserted by the Applicant would be specific and substantial. That showing must contain an explanation that clearly sets forth the reasoning used in concluding that the asserted utility for the claimed invention is not both specific and substantial, nor well supported.

Here, the application supports a clear, specific, and substantial utility. That utility is that watermarks can be embedded within digital content to ensure that advertisements included in that digital content are played.

A. A Specific And Substantial Utility Is Set Forth In the Specification

As pointed out in the background, page 1, line 15, a variety of stripping programs, fast forwarding functions, muting, and masking functions are available in digital playback devices. The risk arises for advertisers that users may avoid actually playing the advertising material in a human understandable way. The described watermark detector 60 determines whether a watermark is present in the content received from a content provider and whether that content was actually played as intended. For example, the watermark detector may detect whether the watermark material is played in full at the determined play speed and is not otherwise muted, masked, fast forwarded, or stripped from the content. See page 4, lines 11-15.

Thus, there is a clear, specific, and substantial utility set forth in the specification. The Examiner's analysis ignores the specification, relies on an improper interpretation of the word watermark in the claims, and contends that the term "watermark" could be so broadly worded as

to cover things that are not useful. Of course, the Examiner's analysis turns the required Section 101 analysis on its ear. The M.P.E.P. makes it explicitly clear that the Examiner must also consider the specification and determine whether utility was set forth therein. This the Examiner never did. He simply ignored the specification and focused on the claims.

Thus, the Examiner's rejection under Section 101 should be reversed since there is a specific and substantial utility set forth in the specification and the Examiner failed to meet his burden of showing that one of ordinary skill in the art could not find a specific and substantial utility from the specification.

B. The Interpretation Of Watermark Is Overly Broad

While the Examiner's total focus on the claims is inappropriate, his Section 101 claim based analysis is also erroneous for an additional reason. The Examiner suggests that he is entitled to provide his personal broadest possible definition for watermark. He misapprehends the applicable standard, thinking that he can simply engraft essentially any definition on the term that he chooses. He takes this from a misreading of the rules which permit the Examiner to give the broadest permissible definition.

Those rules do not permit the Examiner to assert definitions which are inconsistent with the well established meanings of the term in the art. Here, the Applicant has shown that the term "watermark" has a well established meaning in the art. It is not some abstract idea as suggested by the Examiner, but a very specific electronic term. Ignoring this evidence, the Examiner insists on his right to subjectively define the term.

M.P.E.P. § 2111, which is the basis for the broadest reasonable interpretation rule, also requires that the words be given their plain meaning. See M.P.E.P. § 2111.01. Plain meaning refers to the meaning given to the term by those of ordinary skill in the art. See M.P.E.P. §

2111.01 at page 2100-48. There, the M.P.E.P. cites cases which indicate that established dictionaries in the art, such as a chemical dictionary, provide the plain meaning of the term.

In the absence of any showing or support by the Examiner that the plain meaning of the term is different from a well established electronics resource, the Examiner's postulations of what he understands watermarks to be are simply irrelevant. Under the plain meaning rule, which is part of the broadest reasonable interpretation rule, there is simply no support for the Examiner's contention that watermark could be an abstract idea. To the contrary, as established from a well-accepted computer encyclopedia, a digital watermark is a pattern of bits embedded into a file used to identify the source of illegal copies. This is further supported by the cited sections of the specification.


The Examiner has failed to rebut this plain meaning and, therefore, the Section 101 rejection should be reversed.

II. Is The Claimed Invention Anticipated By Any One Of The Number Of Cited References?

While the additional comments concerning the prior art are not understood by the Appellant, it may suffice to say that none of them show a watermark as reasonably defined herein or, in fact, have anything whatsoever to do with such watermarks. Therefore, these references cannot possibly anticipate the claimed invention. Again, as best can be understood, it is believed that the Section 102 rejections are based on the strained construction of watermark, which appears to be so broad as to cover essentially anything. Since this definition and construction is contrary to the plain meaning of the term, it should be rejected and the rejection should be reversed.

Respectfully submitted,

Date: February 5, 2004



Timothy N. Trop, Reg. No. 28,994
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Ste. 100
Houston, TX 77024
713/468-8880 [Phone]
713/468-8883 [Fax]